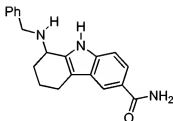


## REMARKS

Claims 1-104 are pending. Claims 60, 65, 84, 87, and 90 stand rejected. Claims 66, 85, 86, and 88 are objected to. Claims 1-59, 61-64, 67-83, 89, and 91-104 are withdrawn from consideration. Applicants request reconsideration of the claims in light of the comments presented herein.

### Election/Restriction

The Examiner has acknowledged that the elected species appears to be allowable, however, the Examiner alleges that the following non-elected species, Compound I, is obvious over the prior art:



Compound I

The Examiner has given effect to the elected species and non-elected species were withdrawn from consideration (Office Action at items 2-4). As set forth below, Applicants respectfully assert that Compound I is not obvious over the prior art as alleged by the Examiner.

Claims 1-59, 61-64, 67-83, 89, and 91-104 stand withdrawn as directed to the allegedly separate invention of Group I.

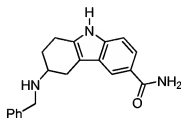
### Claim Objections

Claims 60, 65, 66, 84-88, and 90 are objected to for containing non-elected subject matter (Office Action at item 5). Applicants respectfully request that these objections be withdrawn in light of the allowability of the generic claims as clarified in the discussion of the rejection that follows.

Rejection Under 35 U.S.C. §103

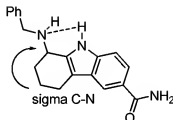
Claims 60, 65, 84, 87, and 90 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over King et al. (caplus an 1993: 212888) (Office Action at item 6). This rejection is respectfully traversed.

Compound I above is allegedly obvious in view of Compound II of King et al.:



Compound II

The Examiner alleges that because Compound I and Compound II are positional isomers, there is a presumed expectation that such compounds possess similar properties. Applicants respectfully disagree that one skilled in the art would expect these positional isomers to display similar properties. For example, Compound I possesses two nitrogen atoms in proximity that allows intramolecular hydrogen bonding, as shown below, or allows the possibility of forming a metal chelate (not shown):



Compound I (intramolecular hydrogen bonding)

An electronic difference is also apparent upon inspection of Compound I and II. The benzylated nitrogen in Compound I is also in a benzylic-like position relative to the indole unsaturation, whereas in Compound II there is an additional methylene group separating the analogous nitrogen from the indole unsaturation. A substantial electronic difference, in molecular orbital terms, arises because of interactions between the pi orbital system (bonding

and anti-bonding) of the indole ring with the sigma C-N bond shown in the formula for compound I. This interaction can manifest in reactivity differences such as the facile reductive cleavage of carbon heteroatom sigma bonds in allylic and benzylic-like systems, such as the sigma C-N bond shown in compound I. These orbital interactions are absent in compound II. Thus, based on structural and electronic differences alone, one skilled in the art would not expect these compounds to have similar properties.

Moreover, the Examiner is deficient in showing a *prima facie* case of obviousness because there was no reasoning presented by the Examiner as to why one skilled in the art would be motivated to use Compound II as taught by King et al. as a lead compound for the discovery of Compound I.

“An obviousness argument based on structural similarity between claimed and prior art compounds ‘clearly depends on a preliminary finding that one of ordinary skill in the art would have selected [the prior art compound] as a lead compound.’” *The Proctor and Gamble Company v. Teva Pharmaceuticals USA, Inc.* Case Nos. 08-1404, -1405, -1406 (Fed. Cir., May 13, 2009) quoting Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd., 492, F.3d at 1359 (Fed. Cir. 2007).

“it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound.” Takeda 492 F.3d at 1350, 1357, emphasis added.

Thus, the Examiner has not provided reasoning for 1) choosing Compound II as a lead compound, nor 2) provided a reason to modify Compound II in a particular manner to provide Compound I.

For at least these reasons, Applicants assert that claims 60, 65, 66, 84-88, and 90 are patentable over King et al. and respectfully request withdrawal of this rejection. Applicants assert that the generic claims are now in condition for allowance and respectfully request further withdrawal of the objections to claims 60, 65, 66, 84-88, and 90.

**Application No.: 10/576,045**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

/Victor Behar/

Victor Behar  
Registration No. 60,691

11682 El Camino Real, Suite 400  
San Diego, CA 92130  
Phone: 858.720.3300 VB:ARS:Ilf  
Facsimile: 858.720.7800  
**Date: November 13, 2009**

**Please recognize our Customer No. 83729  
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